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NO. 7430 P. 6/10

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Dated: August 29, 2003

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(Sharon M. Smith)

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Docket No.: 28335/37036US  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Kunal Saha

Application No.: 10/040,802

Group Art Unit: 1648

Filed: December 28, 2001

Examiner: J. Stucker

For: METHODS AND MATERIALS RELATING  
TO CD8- TROPIC HIV-1

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
Washington, DC 20231

Dear Sir:

In a restriction requirement dated May 30, 2003, in the above-identified matter, the Patent Office alleged that pending claims 1-56 were directed to ten distinct inventions. This election is timely filed with a petition and fee for two-months extension of time.

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**I. Restriction**

Citing 35 U.S.C. § 121, the Examiner alleged that claims 1-56 were drawn to ten distinct inventions:

- I. Claims 1-10, 29, and 39-55, drawn to gp120 polypeptides;
- II. Claims 11-23, 30 and 31, drawn to a nucleic acid encoding a polypeptide;
- III. Claims 24, 25, and 38, drawn to an antibody;
- IV. Claims 26 and 34, drawn to a method of administering a polypeptide;
- V. Claims 27 and 28, drawn to a method of administering cells;
- VI. Claim 32, drawn to a method of detecting polypeptides;
- VII. Claim 33, drawn to a method of detecting nucleic acids;
- VIII. Claims 35 and 36, drawn to a method of administering an antibody;
- IX. Claim 37, drawn to administering a small molecule; and
- X. Claim 56 drawn to a gp41 polypeptide.

**II. Election**

The Applicants hereby elect Group I, which includes claims 1-10, 29 and 39-55 drawn to gp120 polypeptides.

**III. Traversal of Restrictions****A. The Applicants traverse the restriction of claim Groups I and II**

The polypeptides of Group I are encoded by the polynucleotide sequences of Group II. It is probable that a search based on the polypeptides sequences of Group I will involve the same prior art and identify similar art compared to a search based on the polynucleotides of Group II. Moreover, existing search engines permit a searcher to search translations of known polynucleotide sequences in all reading frames automatically, permitting rapid comparisons of polynucleotide and polypeptide databases. Thus, it would not be a serious burden on the Examiner to do one search based on the claims in Groups I and

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II. Applicants respectfully request that the restriction requirement with respect to Groups I and II be withdrawn and these groups be examined simultaneously.

**B. The Applicants traverse the restriction of claim Groups I and III**

The antibodies of Group III specifically bind to the polypeptides of Group I. If the search based on the polypeptides of Group I indicates these polypeptides are novel and non-obvious, the antibodies of Group III should also be novel and non-obvious. Thus, it would not be a serious burden on the Examiner to do one search based on the claims in Group I and III. Applicants respectfully request that the restriction requirement with respect to Groups I and III be withdrawn and these groups be examined simultaneously.

**C. The Applicants traverse the restriction of claim Groups I and IV**

The Group IV method of eliciting an immune response to a CD8-trophic HIV-1 comprise administering one or more of the polypeptides of Group I. This interrelatedness is substantiated by the fact that method claim 34 (Group IV) depends from a claim in Group I. If the polypeptides of Group I (product claims) are found novel and non-obvious under 35 U.S.C. §103(a), the Applicants may be entitled to rejoinder of claims to methods of using that product. *See* 1184 OG 86, (1996). The Applicants hereby request that, if the product claims of Group I are allowed, the Patent Office rejoin the method claims of Group IV. To facilitate efficient examination, the Applicants request that the claims of Group I and Group IV be examined simultaneously. The small number of claims in Group IV and their relatedness to Group I suggest there will be no serious burden involved. Applicants respectfully request that the restriction requirement with respect to Groups I and IV be withdrawn and these groups be examined simultaneously.

**D. The Applicants traverse the restriction of claim Groups I and VI**

The Group VI method of detecting CD8-trophic HIV-1 comprises detecting one or more of the polypeptides of Group I. If the polypeptides of Group I (product claims) are found novel and non-obvious under 35 U.S.C. §103(a), the Applicants may be entitled to rejoinder of claims to methods of using that product. *See* 1184 OG 86, (1996). The Applicants hereby request that, if the product claims of Group I are allowed, the Patent Office rejoin the method claims of Group VI. To facilitate efficient examination, the Applicants request that the claims of Group I and Group VI be examined simultaneously.

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The small number of claims in Group VI and their relatedness to Group I suggest there will be no serious burden involved. Applicants respectfully request that the restriction requirement with respect to Groups I and VI be withdrawn and these groups be examined simultaneously.

**CONCLUSION**

It is respectfully requested that the restriction requirement between Groups I, II, III, IV and VI be withdrawn, and these groups be examined simultaneously with elected Group I.

Respectfully submitted,

Dated: August 29, 2003

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The Patent Office is hereby requested to acknowledge receipt  
of the following papers by stamping and returning this card.

Saha

10/040,802

Petition for Extension of time Fee \$ 205.00 ck# 8910

Response to the Office Action dated: 5/30/03

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